

**REMARKS****I. Summary**

Claims 1-11 and 13-23 are pending in the application. In the Final Office Action mailed July 11, 2003, claims 1-11 and 13-23 were rejected. Claims 1, 13, and 14 have been amended. No new matter has been added. The issues in the Final Office Action are:

- Claims 1-11 and 13-23 are rejected under 35 U.S.C. § 112, first paragraph.
- Claims 1, 2, 8, 11, 13, 14, 20, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* (U.S. Patent No. 5,827,567) in view of *Chen et al.* (U.S. Patent No. 5,709,949, hereinafter *Chen*), further in view of *Fukui et al.* (U.S. Patent No. 4,673,712, hereinafter *Fukui*).
- Claims 9, 10, 12, 21, 22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui* and further in view of *Chen*.
- Claims 4, 6, 7, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui*, further in view of *Chen*, further in view of *Dutheil et al.* (U.S. Patent No. 5,891,515, hereinafter *Dutheil*).
- Claims 5 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui*, further in view of *Chen*, and further in view of *Parthasarathy* (U.S. Patent No. 4,104,416).
- Claims 3 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui*, further in view of *Chen*, and further in view of *Niskanen et al.* (U.S. Patent No. 5,342,812, hereinafter *Niskanen*).

Applicant respectfully traverses the claim rejections in view of the reasons set forth below and for reasons presented in the Response mailed May 18, 2005.

II. Applicant's Record Under § 713.04 of Telephone Interview with Examiner

Applicant thanks the Examiner for the telephone interview of August 22, 2005, regarding this matter. Applicant respectfully submits the following record of the telephone interview under M.P.E.P. § 713.04. The following persons participated in the interview: Examiner Frederick J. Parker and Applicant's attorney Mark E. Flanigan.

Regarding the claim rejection under 35 U.S.C. § 112, first paragraph, Applicant proposed amending claims 1 and 13 with additional language supported by the specification. Applicant proposed amending claims 1 and 13 with the additional limitation of "wherein said tool comprises composite material."

Regarding the claim rejections under 35 U.S.C. § 103(a), additional language clarifying methods claimed in claims 1 and 13 was proposed.

The Examiner agreed to permit and consider amendments corresponding to the proposals above.

III. Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-11 and 13-23 are rejected under 35 U.S.C. § 112, first paragraph as not being enabled by the specification. Applicant has amended claims 1 and 13 to recite the additional limitation of "wherein said tool comprises composite material." This language is supported by the specification at, for example, page 6, third paragraph and page 9, first paragraph. Applicant respectfully asserts that amended claims 1 and 13 are fully enabled by the specification.

Claims 2-11 and 14-23 depend directly or indirectly from base claims 1 and 13. As shown above, claims 2-11 and 14-23 comprise all limitations of the base claims from which they depend. Applicant respectfully asserts that, in view of the amendment to claims 1 and 13, that claims 2-11 and 14-23 are also fully enabled by the specification. Additionally claim 14 has been amended to correspond with amended claim 13.

In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-11 and 13-23 under 35 U.S.C. § 112, first paragraph.

**IV. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 1-11 and 13-23 have been rejected under 35 U.S.C. § 103(a) as obvious over *Molitor* in combination with various references. Claims 1, 13, and 14 have been amended to recite additional clarifying limitations. These limitations are supported by the specification at, for example, page 3, fourth paragraph, page 7, first paragraph, and page 9, second paragraph. Thus, no new matter has been added.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

**Claims 1, 2, 8, 11, 13, 14, 20, and 23**

Claims 1, 2, 8, 11, 13, 14, 20, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Chen*, further in view of *Fukui*.

Claim 1 recites “applying a primer to said surfactant-coated surface of a tool.” *Molitor* teaches a method of preparing a game ball mold cavity. *See* col. 1, lines 6-7. *Molitor* teaches a mold cavity preparation technique comprising in the first step shot peening or air blasting using an abrasive media. *See Molitor* at col. 1, lines 24-59. “After blasting, the hemispherical opening and land area of the mold cavity are primed.” *See id.* *Molitor* does not teach or suggest applying a surfactant solution before priming. Accordingly, *Molitor* does not teach or suggest at least “applying a primer to said surfactant-coated surface of a tool” as recited in claim 1.

The Examiner states that *Fukui* teaches the use of a mold coating which “prevents sticking of subsequently contacting solid being formed.” *Fukui* teaches a copolymer useful as a “mold release agent, a non-tackifier and a water- and oil-repellant.” *See Fukui* at col. 1, lines 17-21. Applicant respectfully asserts that *Fukui* does not teach or suggest a surfactant to which a primer can be applied. Accordingly, *Fukui* does not teach or suggest at least the above-recited limitation of claim 1.

*Chen* teaches coated fuser members prepared by applying a fluoroelastomer layer to a primer layer. *See Chen* at col. 8, lines 20-55. *Chen* does not teach or suggest applying a primer to a surfactant-coated surface of a tool. Accordingly, *Chen* does not teach or suggest the above-recited limitation of claim 1. Because *Molitor* in view of *Fukui*, further in view of *Chen* does not teach or suggest all limitations of claim 1, claim 1 is not obvious over the cited references.

Claim 13 recites “applying a primer to the surfactant-coated uncovered portion of the surface.” *Molitor* teaches a method of preparing a game ball mold cavity. *See* col. 1, lines 6-7. *Molitor* teaches a mold cavity preparation technique comprising in the first step shot peening or air blasting using an abrasive media. *See Molitor* at col. 1, lines 24-59. “After blasting, the hemispherical opening and land area of the mold cavity are primed.” *See id.* *Molitor* does not teach or suggest applying a surfactant solution before priming. Accordingly, *Molitor* does not teach or suggest at least “applying a primer to the surfactant-coated uncovered portion of the surface” as recited in claim 13.

The Examiner states that *Fukui* teaches the use of a mold coating which “prevents sticking of subsequently contacting solid being formed.” *Fukui* teaches a copolymer useful as a “mold release agent, a non-tackifier and a water- and oil-repellant.” *See Fukui* at col. 1, lines 17-21. Applicant respectfully asserts that *Fukui* does not teach or suggest a surfactant to which a primer can be applied. Accordingly, *Fukui* does not teach or suggest at least the above-recited limitation of claim 13.

*Chen* teaches coated fuser members prepared by applying a fluoroelastomer layer to a primer layer. *See Chen* at col. 8, lines 20-55. *Chen* does not teach or suggest applying a primer to a surfactant-coated uncovered surface of a tool. Accordingly, *Chen* does not teach

or suggest the above-recited limitation of claim 13. Because *Molitor* in view of *Fukui*, further in view of *Chen* does not teach or suggest all limitations of claim 13, claim 13 is not obvious over the cited references.

Claims 2, 8, 11, 14, 20, and 23 depend directly or indirectly from claims 1 and 13. As such, they comprise all limitations of the base claim from which they depend. As shown above, not all limitations of claims 1 and 13 are taught by the cited references. Accordingly, not all limitations of claims 2, 8, 11, 14, 20, and 23 are taught by the cited references. Accordingly, claims 2, 8, 11, 14, 20, and 23 are not obvious over *Molitor* in view of *Fukui*, further in view of *Chen*. In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of record and pass claims 1, 2, 8, 11, 13, 14, 20, and 23 to issue.

#### **Claims 9, 10, 12, 21, 22, and 24**

Claims 9, 10, 12, 21, 22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui* and further in view of *Chen*. Applicant respectfully notes that claim 24 was canceled without prejudice in the previous Response dated May 18, 2005.

Claims 9, 10, 12, 21, 22, and 24 depend directly or indirectly from claims 1 and 13. As such, they comprise all limitations of the base claim from which they depend. As shown above, not all limitations of claims 1 and 13 are taught by the cited references. Accordingly, not all limitations of claims 9, 10, 12, 21, 22, and 24 are taught by the cited references. Thus, claims 9, 10, 12, 21, 22, and 24 are not obvious over *Molitor* in view of *Fukui*, further in view of *Chen*. In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of record and pass claims 9, 10, 12, 21, 22, and 24 to issue.

#### **Claims 4, 6, 7, 16, 18, and 19**

Claims 4, 6, 7, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui*, further in view of *Chen*, further in view of *Dutheil*. Claims 4, 6, 7, 16, 18, and 19 depend directly from claims 1 and 13. As such, they comprise all limitations of the base claim from which they depend. As shown above, not all

limitations of claims 1 and 13 are taught by *Molitor* in view of *Fukui*, further in view of *Chen*. *Dutheil* does not cure the deficiencies of those references with respect to claims 1 and 13. *Dutheil* teaches a metal substrate “which may have been subjected beforehand to one or more surface treatments such as alkali degreasing, brushing, shot-blasting, phosphatizing, hot rinsing, etc.”. *See Dutheil* at col. 2, lines 10-14. However, *Dutheil* does not teach or suggest at least the limitation of “applying a primer to said surfactant-coated surface of a tool,” as recited by claim 1, or “applying a primer to the surfactant-coated uncovered portion of the surface” as recited by claim 13. *Molitor* in view of *Fukui*, further in view of *Chen*, further in view of *Dutheil* does not teach or suggest all limitations of claims 1 and 13. Accordingly, the cited references do not teach or suggest all limitations of claims 4, 6, 7, 16, 18, and 19. Thus, claims 4, 6, 7, 16, 18, and 19 are not obvious over *Molitor* in view of *Fukui*, further in view of *Chen*, further in view of *Dutheil*.

### **Claims 5 and 17**

Claims 5 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui*, further in view of *Chen*, and further in view of *Parthasarathy*. Claims 5 and 17 depend directly from claims 1 and 13. As such, they comprise all limitations of the base claim from which they depend. As shown above, not all limitations of claims 1 and 13 are taught by *Molitor* in view of *Fukui*, further in view of *Chen*. *Parthasarathy* teaches “application of two layers of powder material on a substrate.” *See Parthasarathy* at col. 3, lines 4-5. However, *Parthasarathy* does not teach or suggest at least the limitation of “applying a primer to said surfactant-coated surface of a tool,” as recited by claim 1 or “applying a primer to the surfactant-coated uncovered portion of the surface” as recited by claim 13. *Parthasarathy* does not cure the deficiencies of *Molitor* in view of *Fukui*, further in view of *Chen* with respect to base claims 1 and 13. Accordingly, *Molitor* in view of *Fukui*, further in view of *Chen*, and further in view of *Parthasarathy* does not teach or suggest all limitations of claims 5 and 17. Thus, claims 5 and 17 are not obvious over the cited references.

**Claims 3 and 15**

Claims 3 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Fukui*, further in view of *Chen*, and further in view of *Niskanen*. Claims 3 and 15 depend directly from claims 1 and 13. As such, they comprise all limitations of the base claim from which they depend. As shown above, not all limitations of claims 1 and 13 are taught by *Molitor* in view of *Fukui*, further in view of *Chen*. *Niskanen* teaches composite materials for use as golf club heads. *See Niskanen* at col. 1, lines 10-20. However, *Niskanen* does not teach or suggest at least the limitation of “applying a primer to said surfactant-coated surface of a tool,” as recited by claim 1 or “applying a primer to the surfactant-coated uncovered portion of the surface” as recited by claim 13. *Niskanen* does not cure the deficiencies of *Molitor* in view of *Fukui*, further in view of *Chen* with respect to base claims 1 and 13. Accordingly, *Molitor* in view of *Fukui*, further in view of *Chen*, and further in view of *Niskanen* does not teach or suggest all limitations of claims 3 and 15. Thus, claims 3 and 15 are not obvious over the cited references.

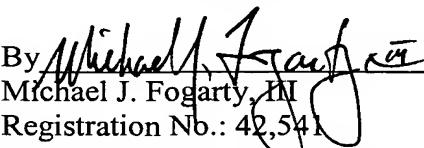
**V. Conclusion**

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 46030/P031D1/10407127 from which the undersigned is authorized to draw.

Dated: September 12, 2005

Respectfully submitted,

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